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10/792,038	03/03/2004	Melissa K. Rath	ATMI-668	4823
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LE, HOA VAN				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/792,038

Filing Date: March 03, 2004

Appellant(s): RATH ET AL.

Tristan A. Fuierer, Ph. D.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 03/11/10 appealing from the
Office action mailed on 02/24/09

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

There is no other appeal or interference.

(3) Status of Claims

Claims 1, 2, 4-6, 10, 15, 17-21, 53, 56 and 57 are pending.

Claim 57 is objected.

The elected species of Formulation G in claim 7 is allowed.

Claims 3, 8, 9, 11-13, 16, 22, 23, 32, 36-38, 40-42, 51 and 52 were cancelled.

Claims 7, 14, 24-31, 33-35, 39, 43-50, 54-55 and 58-59 were withdrawn.

The following is a list of claims that are rejected and pending in the application:

They are claims 1, 2, 4-6, 10, 15, 17-21, 53 and 56.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The statements of the grounds of rejections to be reviewed are correct.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

2003/0130147	Koito et al	07-2003
2004/0134682	En et al	07-2004
5,849,467	Sato et al	12-1998
10/389,214	Minsek et al	03-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(A) Claims 1-2, 4-5, 10, 15, 19-20 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koito et al (2003/0130147) considered in view of En et al (2004/0134682) or Sato et al (5,849,467).

Koito et al disclose, teach and suggest a liquid cleaning (stripping and removing) composition of an unwanted material (on at least paragraph 0002). The composition comprises a quaternary base (on at least paragraph 0085) and adenine (as the applied species of “one additional component selected from...chelator, an oxirane species, and combinations their of...adenine...” in the appealed independent claim 1) being disclosed, taught and suggested in Koito et al on at least paragraph 0029, 0031, 0045, 000076, 0077. The liquid cleaning composition is suggested to be safe and/or acceptable to be operated in a pH range of from 6 to 12 (on at least paragraph 0016). When a liquid cleaning composition is highly alkaline with a pH higher than 12, a buffering agent is suggested to be added to the liquid cleaning composition to bring the pH down in the desired range of from 12 to 6 (on at least paragraphs 0016, 0083).

Koito et al do not specify an alkali base. However, it is known in the art at the time the invention was made to obtain and use an alkali base (including potassium hydroxide alkaline agent) for the purpose of providing an alkalinity to liquid cleaning composition. Evidence can be seen in at least En et

al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774 or in Sato et al on at least on col.3:52 to 4:61, 5:41-48, 7:34-48, Examples 1, 5 and 8.

Since the above references are all related to liquid cleaning compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite an alkali base as a known alkaline agent in the art for a reasonable expectation of providing an alkalinity property in a liquid cleaning composition as known to one having ordinary skill in the art at the time the invention was made and disclosed, taught, suggested by one of the secondary references.

(B) Claims 1, 4-6, 10, 15, 17-21, 53 and 56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-6, 12-17, 33-36, 39, 42-47 as amended on 01/10/08 of copending Application No. 10/389,214 (and its teachings and suggestions in the specification on at least paragraphs 9, 12, 13, 17, 18, 21, 23, Examples 2, 4 and 5) considered in view of En et al ((2004/0134682) as a secondary reference).

Applicants (in the copending Application No. 10/389,214 and its broadly claimed embodiments) broadly disclosed, taught and suggest claims with a liquid

cleaning composition “comprising” a nitrogen containing base (tetramethylammonium hydroxide) as those in the instant claims and a chelator of 1-amino-1,2,4-triazole; 1-amino-1,2,3-triazole; 1-amino-5-methyl- 1,2,3-triazole; 3-isopropyl-1,2,4-triazole; naphthotriazole; 2-mercaptobenzimidazole; 5-aminotetrazole; 5-amino-1,3,4-thiadiazole-2-thiol; 2,4- diamino-6-methyl- 1,3,5-triazine; triazine; methyltetrazole; 1,5-pentamethylenetetrazole; 1-phenyl-5-mercaptotetrazole; diaminomethyltriazine; imidazoline thione; 4-methyl-4H- 1,2,4-triazole-3-thiol).

There is no teaching or suggestion of an alkali base in the copending Application No. 10/389,214. However, prior to the instant invention in the above applied application was made, it is known in the art at the time the invention was made to obtain and use an alkali base (including potassium hydroxide alkaline agent) for the purpose of providing an alkalinity to liquid cleaning composition. Evidence can be seen in at least En et al at paragraph 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774.

Since the above references are all related to cleaners, stripper and/or removers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite potassium hydroxide alkaline agent for a reasonable expectation of sufficiently providing an additional alkalinity and stripping power to one having ordinary skill in the art.

(10) Response to Argument

(A) 35 USC 103 prior art rejection:

Applicant's arguments filed 03/11/10 have been fully considered but they are not persuasive.

Applicant recognizes that the applied primary reference, Koito et al., is related to a liquid cleaning composition comprising a quaternary ammonium from 1 wt%, and an effective amount of adenine as anti-corrosive agent to sufficiently provide an anti-corrosive property. This is very similar to at least the instant claims 1 and 4 that claim a quaternary base and a chelator (adenine is one of the specified chelators in claim 1).

Appellants correctly note that the Examiner stated that the reference suggests the inclusion of an amount of a known alkali base (including potassium hydroxide as the alkaline agent) for the purpose of providing alkalinity to the liquid cleaning composition since the cited references show that it is known in the art to obtain and use an alkali base (including potassium hydroxide alkaline agent) for the purpose of providing alkalinity to the liquid cleaning composition. Evidence can be seen in at least En et al at paragraphs 0550, 0600, 0612, 0620, 0653, 0714, 0754 and 0774 or in Sato et al in at least col.3:52 to 4:61, 5:41-48, 7:34-48, Examples 1, 5 and 8.

Since the above references are all related to liquid cleaning compositions, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to use an alkali base as a known alkaline agent in the art for a reasonable expectation of providing alkalinity to a liquid cleaning composition as taught by the secondary references.

Applicant points to the results in Table 1 with the specific “Stripping agent No.” 2, 3 and 4. Stripping agent No. 2 has the best results with a pH value of about 8.6. Stripping agent Nos. 3 and 4 show somewhat inferior results than those in Stripping agent No. 2 because they generally have a lower amount of an organic acidic (e.g. lactic acid) buffer. In Table 1, Koito et al also show that Stripping agent No. 9 has the best results at a pH value of about 8.5 while Stripping agent No. 8 has decreased results than those in Stripping agent No. 9 because Stripping agent No. 8 contains an insufficient amount (only about 0.001 wt%) of anti-corrosive adenine. Accordingly, Koito et al. show in Table 1 that the best results are not always obtained at pH value of about 8.5 to 8.6, but if the sample also contains a sufficient amount of anti-corrosive adenine (i.e. higher than the insufficient amount of about 0.001 wt% as that in Stripping agent No. 8) then good results are obtained.

Koito et al disclose that there are some stripping agents that show the best results (Stripping agent Nos. 2 and 9 in Table 1). However, Koito et al also disclose that the stripping agents perform adequately with the use of the

stripping agents having a pH value in the range from about 6 to 12 (on at least paragraph 0016).

Koito et al also disclose that the pH of a stripping agent can be in the range of from about 6 to 12 with the use of a buffering agent, or a mixture of buffering agents, in at least paragraphs 0016 and 0083.

The strong alkalinity property mentioned by Appellant in Exhibits 4 and 5 are noted. However, the applied primary reference, Koito et al., teaches that when a liquid cleaning composition is highly alkaline with a pH higher than 12, a buffering agent should be added to the liquid cleaning composition to bring the pH down in the desired range of from 6 to 12 (see at least paragraphs 0016 and 0083).

Applicant urges that the rejection is based on a hindsight reconstruction. However, the rejection is not based on impermissible use of hindsight because it does not depend on any information that can be gleaned only from applicant's specification in accordance with the authority stated in *In re McLaughlin*, 170 USPQ 209.

(B) Obviousness-type double patenting rejection:

The Examiner would like to note that the composition of formula G as the elected species in claim 7 is not considered to be obvious over the applied references. In fact, the elected species of formula G in claim 7 has been indicated to be allowable if claim 7 would be rewritten in an independent form (see the Office Action mailed on 06/02/05 at paragraph "X").

Appellant has stated that the examiner has improperly looked to the specification in the obviousness double patenting rejection. The examiner would like to direct attention to claim 17 of the reference application 10/389,214. These chelators of the reference claim 17 are what is being claimed as chelators in instant claim 1. Instant claim 1 recites numerous triazoles, tetrazoles, imidazoles, phosphates, thiols just as the reference's claim 17. Thus it is not necessary to look to the specification of the reference. Though, the specification of the reference (paragraph 0018) does indicate that the reference contemplates to use exactly the same compounds as presently claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Hoa V. Le/

Primary Examiner, Art Unit 1795

Conferees:

/Mark F. Huff/

Supervisory Patent Examiner, Art Unit 1795

/Anthony McFarlane/